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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hiroaki Harada

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STAAS & HALSEY LLP

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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,716

Applicant(s)

HARADA ET AL.

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-12 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-12, and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. In the amendment filed 7/7/06, the following has occurred: claims 1-7 and 9-12 have been amended, claim 8 has been canceled, claim 20 has been added, and claims 13-19 are withdrawn. Now, claims 1-7, 9-12, and 20 are presented for examination.
2. The rejections under 35 U.S.C. 101 and 112 are withdrawn by the Examiner based on changes made by Applicants to the claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 20 is rejected under 35 U.S.C. 102(e) as being anticipated by DiMattina, U.S. Patent No. 6,405,177.
5. As per claim 20, DiMattina teaches an insurance task processing method comprising: transmitting transactional information in a transaction related to electronic commerce (see column 3, lines 48-55); fudging whether or not a solicitation-related keyword is included in the transmitted transactional information (see column 3, lines 56-62, the Examiner interprets data regarding items the purchaser wishes to buy to be a form of solicitation-related keyword); and receiving solicitation-to-insurance information transmitted from a server of an insurer, when said judging determines that the solicitation-related keyword is included in said transmitted transactional information (see column 3, line 63 - column 4, line 21).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6-7, and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiMattina, U.S. Patent No. 6,405,177 in view of Furusawa et al., U.S. Patent No. 6,934,738.

8. As per claim 1, DiMattina teaches an insurance task processing method comprising: checking electronic information distributed within a computer network to judge whether or not a solicitation-related keyword is included in the electronic information (see column 3, lines 56-62, the Examiner interprets data regarding items the purchaser wishes to buy to be a form of solicitation-related keyword); and distributing solicitation-to-insurance information to at least one of involved parties having exchanged the electronic information with each other, when it is judged that the solicitation-related keyword is included in the electronic information (see column 3, line 63 - column 4, line 21). DiMattina does not explicitly teach that the electronic information is cross-checked with a word table in which a solicitation-related keyword as a clue of solicitation-to-insurance is registered. Furusawa teaches a method of processing messages in an electronic network in which messages are cross-checked with a word table where keywords are registered and performing associated programs based on identified keywords contained in the messages (see column 5, lines 21-34). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such keyword lookup table functionality into the system of DiMattina. One of ordinary skill in the art would have been motivated to

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incorporate such a feature for the purpose of providing uniformity in the message processing of DiMattina (see column 1, lines 37-42 of Furusawa).

9. As per claim 2, DiMattina in view of Furusawa teaches the method of claim 1 as described above. DiMattina further teaches said distributing distributes the solicitation-to-insurance information to the involved party when the involved party has not yet subscribed to insurance (see column 3, line 58 – column 4, line 3, since the insurance is offered for the particular transaction, the involved party has not yet subscribed to insurance).

10. As per claim 3, DiMattina in view of Furusawa teaches the method of claim 2 as described above. DiMattina further teaches said distributing distributes the solicitation-to-insurance information to the involved party even when the involved party has already subscribed to insurance, if the insurance is invalid, or if the involved party has experienced an encounter with an accident related to electronic commerce in the past (see column 3, line 58 – column 4, line 3, since DiMattina does not give any restrictions on when the insurance information is distributed, it would still be distributed under these conditions).

11. As per claim 4, DiMattina teaches the method of claim 1 as described above. DiMattina further teaches said distributing distributes the solicitation-to-insurance information from an insurer selected corresponding to contents of the electronic information (see column 3, lines 47-55).

12. As per claim 6, DiMattina teaches an insurance task processing method comprising: an inputting transactional information in a transaction related to electronic commerce (see column 3, lines 56-58); transmitting the input transactional information (see column 3, lines 56-58); and receiving solicitation-to-insurance information transmitted from a server of an insurer, when it is judged that a solicitation-related keyword is included in said transmitted transactional information (see column 3, line 58 – column 4, line 3). DiMattina does not explicitly teach that

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the electronic information is cross-checked with a word table in which a solicitation-related keyword as a clue of solicitation-to-insurance is registered. Furusawa teaches a method of processing messages in an electronic network in which messages are cross-checked with a word table where keywords are registered and performing associated programs based on identified keywords contained in the messages (see column 5, lines 21-34). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such keyword lookup table functionality into the system of DiMattina. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of providing uniformity in the message processing of DiMattina (see column 1, lines 37-42 of Furusawa).

13. As per claim 7, DiMattina in view of Furusawa teaches the method of claim 6 as described above. DiMattina further teaches judging whether or not a transactional keyword has been included in said input transactional information (see column 3, line 56-58, the Examiner interprets the data regarding items a purchaser wishes to buy to be a form of "keyword" as recited in the claim); and notifying a risk related to the electronic commerce, when said transactional keyword is judged to be included in the transactional information (see column 3, line 58 – column 4, line 3, the Examiner interprets the "guarantees" to be a form of notification of risk related to the electronic commerce).

14. Claims 10, and 11 recite substantially similar computer medium and system limitations to method claim 1 and, as such, are rejected for similar reasons as given above.

15. Claims 9 and 12 recite substantially similar computer medium and system limitations to method claim 6 and, as such, are rejected for similar reasons as given above.

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16. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over DiMattina, U.S. Patent No. 6,405,177 in view of Furusawa et al., U.S. Patent No. 6,934,738 and further in view of Margoscin et al., U.S. Patent no. 7,003,482.

17. As per claim 5, DiMattina in view of Furusawa teaches the method of claim 1 as described above. DiMattina further teaches receiving insurance premium information which has been calculated corresponding to a price included in the electronic information (see column 5, lines 23-26); calculating the sum of the insurance premium indicated by the received insurance premium information and the price (see column 5, lines 26-29); and presenting the calculated insurance premium and the calculated sum to both of the involved parties (see column 4, lines 14-17 and column 5, lines 44-50).

18. DiMattina does not explicitly teach the insurance premium information is calculated based on a discount insurance premium rate. However, Margoscin teaches a business middleware system for implementing business policy changes including implementing insurance premium discounts (see column 11, lines 44-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of DiMattina. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of easily implementing business policy changes, such as implanting insurance premium discounts (see column 2, lines 34-41).

Response to Arguments

19. In the remarks filed 7/7/06, Applicants argue in substance that (1) the claims are directed to statutory subject matter and are definite in view of the claim amendments; (2) DiMattina does not teach cross-checking as recited in the amended claims; (3) DiMattina does not teach a "solicitation-related keyword as a clue of solicitation-to-insurance."

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20. In response to Applicants' argument (1), the Examiner agrees that the claim amendments have overcome the rejections under 35 U.S.C. 101 and 112 and, accordingly has withdrawn these rejections.

21. In response to Applicants' argument (2), the Examiner notes that a new grounds of rejection have been applied above in view of Furusawa. Therefore, it is respectfully submitted that this argument is now moot in view of the new grounds of rejection detailed above.

22. In response to Applicants' argument (3), the Examiner respectfully maintains that the data regarding items the purchaser wishes to buy is a form of solicitation-related keyword as recited in the claims. Since it must be "judged" that a user has submitted items for purchase before "solicitation-to-insurance" is presented, it is respectfully submitted that the data that represents the items to be purchased functions as a "solicitation-related keyword" as recited in the claims.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

24. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

10/1/06


C. LUKE GILLIGAN
PATENT EXAMINER